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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,250	06/06/2006	Rainer Durth	740116-608	4230

25570 7590 09/22/2008  
ROBERTS MLOTKOWSKI SAFRAN & COLE, P.C.  
Intellectual Property Department  
P.O. Box 10064  
MCLEAN, VA 22102-8064

EXAMINER
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PATEL, DHARTI HARIDAS

ART UNIT	PAPER NUMBER
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2836

NOTIFICATION DATE	DELIVERY MODE
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09/22/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/596,250	<b>Applicant(s)</b> DURTH ET AL.	
	<b>Examiner</b> DHARTI H. PATEL	<b>Art Unit</b> 2836	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

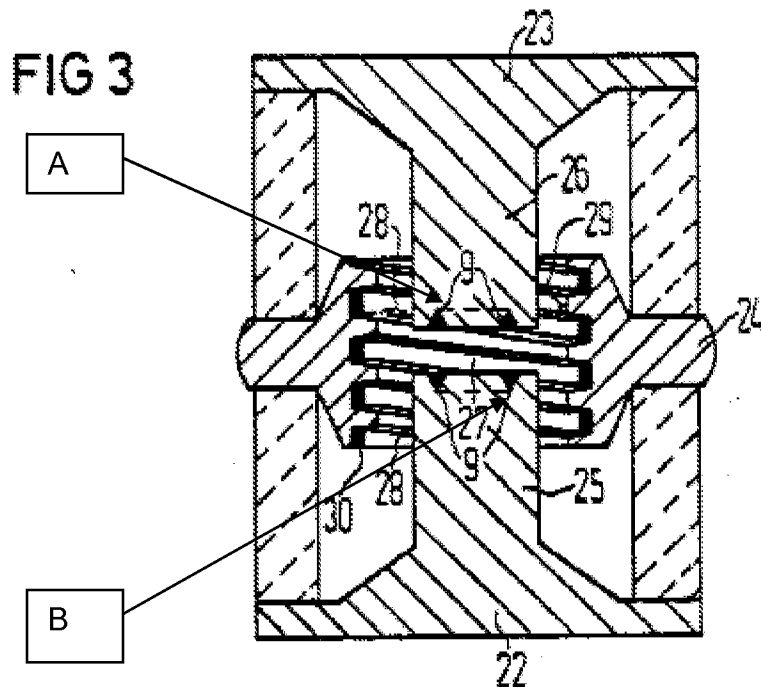
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 13-22 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Boy, Patent No. 4,769,736.

With respect to claim 13, Boy discloses an overvoltage protection means, comprising: a first electrode [Fig. 3; 22; col. 4 lines 64-65], a second electrode [Fig. 3; 23; col. 4 lines 64-65], a breakdown spark gap [Fig. 3; 27; 28; col. 4 lines 63-66] having a discharge space formed between the electrodes [Fig. 3; between the electrodes 22 and 23; col. 4 lines 63-66], an arc forming between the electrodes within the discharge space when the breakdown spark gap is ignited [col. 1 lines 35-47], and a housing [col. 5 lines 59-60] which holds the electrodes [Fig. 3; 22, 23], wherein the discharge space [Fig. 3; 27, 28] is configured in a manner which runs at least one of partially transversely and partially opposite a direction of an electrical field of a prevailing line voltage so that a distance to be overcome by the arc between the two electrodes has a component that is transverse relative said direction of the electrical field as disclosed; and wherein the discharge space extends from a radially outer area of the face of one of the electrodes [A; see the extracted Fig. 3 below; the discharge space coming from point A of electrode 23] to a diametrically opposite radially outer area of the face of the other of the

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electrodes [B; see the extracted Fig. 3 below; the discharge space coming at point B of electrode 22].



**Fig. 3 Extracted from US 4769736**

With respect to claim 14, Boy discloses an overvoltage protection means wherein the discharge space has at least three regions, a first region of which is connected to the first electrode [Fig. 3; the first electrode 22 is connected to the discharge gap 28 at the lower left side of the electrode 22 as shown], a second region of which is connected to the second electrode [Fig. 3; the second electrode 23 is connected to the discharge gap 28 at the upper left side of the electrode 23] and a third region of which is connected between the first region and the second region [Fig. 3; subsidiary discharge gap 27 is connected between the first region and the second region].

With respect to claim 15, Boy discloses that the third region runs essentially perpendicularly to the direction of the electrical field of the prevailing line voltage [Fig. 3; the third region of discharge path 27 is arranged perpendicular to the electric field].

With respect to claim 16, Boy discloses that the third region runs partially obliquely to the direction of the electric field of the prevailing line voltage [Fig. 3; the third region 27 runs partially obliquely, which is sloping or joining something at an angle that is not a right angle].

With respect to claim 17, Boy discloses the third region runs partially opposite the direction of the electric field of the prevailing line voltage [Fig. 3; when the third region 27 runs upward, it runs partially opposite the direction of the electric field].

With respect to claim 18, Boy discloses that a side of the first electrode [Fig. 3; 22] facing the second electrode [Fig. 3; 23] and a side of the second electrode facing the first electrode are partially covered with one of an electrically insulating material and a material of high electrical resistance, an uncovered region of the first electrode and an uncovered region of the second electrode being arranged transversely offset relative to one another [col. 4 lines 63 - col. 5 lines 8; col. 5 lines].

With respect to claim 19, Boy discloses that a side of the first electrode [Fig. 3; 22; col. 4 lines 64-65] facing the second electrode [Fig. 3; 23; col. 4 lines 64-65] and a side of the second electrode facing the first electrode are partially covered with an electrically insulating material [Fig. 1; insulating ring 3, Fig. 3; col. 3 line 65], an uncovered region of the first electrode and an uncovered region of the second electrode being arranged offset to one another, wherein a side of the insulating material facing the

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second electrode and a side of the insulating material facing the first electrode are at least partially covered with a material of high electrical resistance [Fig. 3; the sides of the first electrode and the second electrode are covered with the insulating ring 3], the first electrode being electrically conductively connected to the material of high electrical resistance on the side of the insulating material facing the second electrode in an area remote from the uncovered region of the first electrode and the second electrode being electrically conductively connected to the material of high electrical resistance side of the insulating material facing the first electrode in an area remote from the uncovered region of the second electrode [col. 5 lines 59-61].

With respect to claim 20, Boy further comprises an active ignition aid [col. 1 lines 35-36; col. 5 lines 61-62].

With respect to claim 21, Boy discloses that the active ignition aid comprises a series connection of a voltage switching device [Fig. 3; surge arrester] and an ignition element connected to the two electrodes [Fig. 3; electrodes 22 and 23], the sparkover voltage of the voltage switching device being below the sparkover voltage of the breakdown spark gap so that a diversion current first flowing via the ignition element when the voltage switching device responds [col. 1 lines 35-47].

With respect to claim 22, Boy discloses that the voltage switching device is one of a varistor, suppressor diode and a gas-filled voltage arrester [col. 1 lines 5-6].

With respect to claim 24, Boy discloses that the housing [col. 5 lines 59-60] is a metal pressure housing and has an inner insulation housing [Fig. 2; 3; insulating ring].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boy, Patent No. 4,769,736, in view of Danowsky et al., Patent No. 6,111,740.

With respect to claim 23, Boy discloses an ignition element, but does not disclose that the ignition element comprises one of a conductive plastic, a metal material and a conductive ceramic and is in mechanical contact with the second electrode.

Danowsky discloses a surge protection device including a first and a second electrode. Danowsky discloses that the ignition element comprises one of a conductive plastic [col. 1 lines 44-58], a metal material and a conductive ceramic and is in mechanical contact with the second electrode.

Boy and Danowsky are analogous overvoltage/surge protection devices with first and second electrodes. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Danowsky's plastic ignition element, into Boy's surge arrester, for the benefit of plastic having an excellent insulating property.

***Response to Arguments***

Applicant's arguments filed 06/23/2008 have been fully considered but they are not persuasive.

Applicant comments on page 5 of the REMARKS regarding claim 1 that neither of the Boy and Durth patents teach or even suggest the discharge space extending from a radially outer area of the face of one of the electrodes to a diametrically opposite radially outer area of the face of the other of the electrodes.

Examiner points out that Boy reads on this limitation of "wherein the discharge space...of the other of the electrodes." [See above extract Fig. 3 and rejection]

Applicant comments on page of the REMARKS that the Durth patent is not prior art usable under 103, since the present inventors are two of the three inventors named in the Durth et al. patent and the present application and U.S. Patent 7,324,319 were, at the time the invention of the present application was made, commonly owned.

Examiner points out that the Durth reference has been removed and a new reference by Danowsky et al., [Patent No. 6,111,740] has been introduced to meet the limitation of claim 23. [See 103 rejections above].

Based on examiner's best understanding, it is believed that the prior art reference by Boy reads on the amended claim language of independent claim 1.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DHARTI H. PATEL whose telephone number is (571)272-8659. The examiner can normally be reached on 7:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Sherry can be reached on 571-272-2800, Ext. 36. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR /system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael J Sherry/

Supervisory Patent Examiner, Art Unit 2836

/Dharti H Patel/

Examiner, Art Unit 2836

09/13/2008